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D8/446,804
APPLICATION NUMBER: 80 EILING DATES: 11/1/95

AMBRIS NAMED APPLICANT

T ATTY/DOCKET NO:

ROBERT A FRANKS
SCHERING-PLough CORPORATION
ONE GIRALDA FARMS
MADISON NJ 07940-1000

33M1/1215

EXAMINER
SRIVASTAVA, V

ART UNIT
3312
PAPER NUMBER
15

12/15/97
DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 8/28/97

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1 - 6, 8-27 and 56 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1 - 6, 8-27 and 56 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

Art Unit: 3312

Abstract submitted with the amendment filed 8/20/97 is acceptable but does not conform to the requirement that the abstract should be limited to a single paragraph. Applicant should submit a new abstract.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 - 6, 8 - 27 and 56 are rejected under the judicially created doctrine of double patenting over claim of U. S. Patent No. 5,687,710 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Art Unit: 3312

For example, in claim 1, a powder inhaler (10) is disclosed on Page 19, lines (10 - 11), comprising a housing (20) for holding the supply of powdered material as disclosed on Page 19, line (15); a metering plate (180) for holding a metered amount of powdered material as disclosed on Page 27, lines (3 - 5); a spring means as disclosed on Page 31, lines (6 - 121); a rotation limiting means as disclosed on Page 28, lines (6 - 10); a counter means as disclosed on Page 49, lines (4 - 10); a counter ring as disclosed on Page 49, lines (11 - 13); actuating means as disclosed on Page 53, lines (20 - 37) and a display means as disclosed on Page 51, lines (23 - 37).

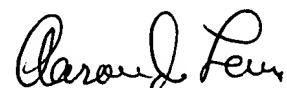
Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

In view of the applicant's argument the rejection of claims 1 - 3, 7 and 25 - 25 has been withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to V. Srivastava whose telephone number is (703) 308-0959.



December 3, 1997



AARON J. LEWIS
PRIMARY EXAMINER
GROUP 3300